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Genentech Inc
Attn Wendy Lee
1 DNA Way
San Francisco, CA 94080-4990

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AUG 18 2005

OFFICE OF PETITIONS

In re Application of	:	
Mark Sliwowski	:	DECISION ON
Application No. 09/602,812	:	PETITION UNDER 1.183
Filed: June 23, 2000	:	and
Attorney Docket No. P1467R2	:	DECISION ON APPLICATION
	:	FOR PATENT TERM ADJUSTMENT
	:	

This is in response to the "PETITION UNDER 37 C.F.R. § 1.183," and the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," both filed April 12, 2005. Applicant requests wavier of the requirement under § 1.705(b) that any request for reconsideration of the patent term adjustment indicated in the notice of allowance be filed no later than the payment of the issue fee. Applicant requests that the initial determination of patent term adjustment be corrected from zero (0) days to three hundred twenty-nine (329) days plus the number of days from the date of the Notice of Allowance until the date that a patent is granted.

The petition under § 1.183 is **DISMISSED**.

RELEVANT STATUTES and RULES

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by

the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

35 U.S.C. 154(b)(3)(B) provides that

Under the procedures established under subparagraph (A), the Director shall-

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination with the written notice of allowance of the application under section 151; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

37 C.F.R. § 1.705 provides, in pertinent part, that:

(a) The notice of allowance will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance.

OPINION

Pursuant to 35 U.S.C. 154(b)(3)(B) and implementing regulation 37 C.F.R. § 1.705, an applicant shall receive an initial determination of patent term adjustment with the mailing of the Notice of Allowance and shall be given one opportunity to request reconsideration of that determination by way of filing

of an application for patent term adjustment prior to the payment of the issue fee.

On January 12, 2005, the Office mailed the initial determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. The issue fee payment was received in the Office on April 8, 2005. No filing of an application for patent term adjustment preceded the payment of the issue fee. The period for filing an application for patent term adjustment requesting reconsideration of the initial determination of patent term adjustment at the time of mailing of the notice of allowance ended upon payment of the issue fee on April 8, 2005.

On April 12, 2005, applicant filed an application for patent term adjustment. In addition, applicant filed the petition requesting waiver of the requirement that the application for patent term adjustment be filed prior to payment of the issue fee. Applicant acknowledges that the issue fee payment was made prior to filing of the application for patent term adjustment. Applicant offers the following facts, as a basis for waiving the timeliness requirement of § 1.705(b):

- Shortly after receiving the Notice of Allowance, outside counsel was asked to review the determination of PTA, but as of April 8, 2005, outside counsel had not completed that review;
- Due to their travel and meeting schedule, applicant's agent was concerned it might be difficult to file the payment of the issue fee during the first part of the week of April 11 and by the 3-month due date. Further, believing in error that the Rules permitted the submission of an application for patent term adjustment after the payment of the issue fee, applicant's agent faxed in payment of the issue fee on April 8, 2005;
- However, counsel completed the review on April 11, 2005, and advised agent that an application for patent term adjustment be filed no later than the payment of the issue fee; and
- The error of failing to submit an application for patent term adjustment before or on the same day as the payment of the issue fee occurred without deceptive intent on the part of applicant's agent or outside counsel.

Having considered applicant's explanation, it is concluded that in this instance waiver of the requirement that the application for patent term adjustment be filed prior to payment of the issue fee is not appropriate. Applicant has not shown that the circumstance of the failure to comply with the time period for filing an application for patent term adjustment set forth in § 1.705(b) is an extraordinary situation for which justice requires waiver.

It is well established that a party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, nor is such an inadvertent omission considered "unavoidable," within the meaning of 15 U.S.C. 1062(b), 35 U.S.C. 133, 37 CFR 1.137(a) or 37 CFR 2.66(a). See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail."), aff'd without opinion, 95 F.3d 1166 (Fed. Cir. 1996); Nitto Chemical Industry. Co., Ltd. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183.); Vincent v. Mossinghoff, 230 USPQ 621 (D.D.C. 1985) (misunderstanding of 37 CFR 1.8 not unavoidable delay in responding to Office Action); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pat. 1985) (counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); In re Chicago Historical Antique Automobile Museum, Inc., 197 USPQ 289 (Comm'r Pat. 1978) (since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

Petitioner has not set forth any other circumstance for violation of the timeliness requirement than believing in error that the rules permitted the submission of an application for patent term adjustment after the payment of the issue fee. Whether, as applicant states, the failure was without deceptive intent is irrelevant. The requirement that the application for

patent term adjustment be filed prior to payment of the issue fee is clearly set forth in the rule. Thus, applicant was expected to be aware of this requirement and to act accordingly. This situation is not distinguishable from those, cited above, in which lack of awareness of a rule was not found to meet the requirements for waiver under § 1.183. Likewise, applicant's lack of awareness of the timeliness requirement of § 1.705(b) is not an extraordinary situation, warranting waiver of the requirement that the application for patent term adjustment be filed prior to payment of the issue fee.

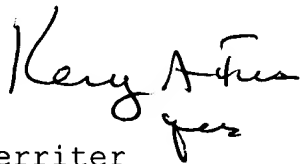
As there is no dispute that this application for PTA was filed after payment of the issue fee and it has been concluded that waiver of the requirement is not warranted, it is appropriate to dismiss this application for patent term adjustment as untimely filed.

In view thereof, it is concluded that the initial determination of Patent Term Adjustment of zero (0) days will not be reconsidered.

The Office acknowledges submission of the \$400.00 fee set forth in 37 CFR 1.17(f) and the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Karin Ferriter", with a stylized flourish at the end.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy